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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,766	07/10/2000	James L. Hepworth	23802-250800	8887

20350 7590 08/10/2005

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EXAMINER

LY, ANH

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,766

Applicant(s)

HEPWORTH ET AL.

Examiner

Anh Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-34 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination (RCE)

1. The request filed on 04/25/2005 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/044,927 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claim 34 has been added (dated 05/24/2005).
3. Claims 1-34 are pending in this Application.

Claim Objections

4. Claim 1 is objected to because of the following informalities: The list line of claim 1, "and/or famous name;" should rewrite as 'and/or famous name.'" Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4, 6-9, 11-15, 17, 19, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0194116 A1 of Coakley in view of US Patent No. 6,009,459 issued to Belfiore et al. (hereinafter Belfiore).

With respect to claim 1, Coakley teaches receiving, from a user, the at least one trademark, tradename, celebrity name, and/or famous name to be searched in the Web page on the Internet (receiving a search request from a user at computer for search trademarks typically based upon a particular goods description or services description or trademark classification; sections 0017; also see section 0015);

automatically creating a search string based on the at least one trademark, tradename, celebrity name, and famous name entered by the user (the search string or search request for a trademark is determined by trademark brokerage engine that checks or determine the search request is available for any trademark within the trademark database: sections 0016 and 0018); and

determining an unauthorized use of the at least one trademark, tradename, celebrity name and/or famous name (trademark brokerage engine that checks or determine the search request is available for any trademark within the trademark database: sections 0016 and 0018).

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018). Coakley does not clearly teach receiving a URL address of Web page on the Internet to be searched, accessing and searching contents of the Web page of the URL address received for matches in the contents of the web page corresponding to the search string wherein the searched contents includes elements other than only a domain name, and providing search results of identified matches in the contents of Web page corresponding to the search string, providing search results of identified matches in the contents of the Web page corresponding to the search string, each category including at least one character string corresponding to a number of occurrences of the identified matches within the

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category, the category selected from the group consisting of a meta-tag, a hidden text, a text, a title, a hyperlink, and an image text, and wherein the report displays the at least one character string.

However, Belfiore teaches after the searching, the search engine locates the URL addresses of web pages on the Internet (col. 5, lines 40-50); the content of web page is located by search engine, and the content of web page is displayed, web page is typically encoded in HTML and most HTML document is identified by a tag or meta tag that gives the elements names and attributes, followed by a content, followed by an end tag. When the search string is found a matched web page is retrieved by a server and or a HTML document is returned, that is, the searched content is including text, URL, HTML (col. 5, lines 40-55), and the search results are displayed as the entered-text is matched based on the search string, that is, entered text or search string retrieved from a search engine from which search results or given web pages are obtained and displayed to the user (col. 5, lines 10-30).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley with the teachings of Belfiore, wherein the searching trademark from a trademark database from a user at a computer over the Internet in the system provided therein (Coakley's fig. 1), would incorporate the use of searching URL address of Web page, accessing and searching the Web page's content of URL address and providing search results, in the same conventional manner as described by Belfiore (col. 5, lines 10-40 and lines 40-55). The motivation being to provide a search over the Internet for potentially user of

trademarks in domain names and other web page content, thereby enforcing the trademark rights within the whole Internet.

With respect to claim 2, Coakley teaches wherein the at least one character string is a number of the identifying matches within the category (the result of search query: abstract and sections 0017-0018).

With respect to claim 3, Coakley teaches an encrypted connection authenticated by a certificate server (section 0016).

With respect to claim 4, Coakley teaches a method of searching as discussed in claim 1.

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018). Coakley does not clearly teach wherein the search results highlight the at least one trademark, tradename, celebrity name or famous name found in the web page.

However, Belfiore teaches secure for sending the message: server with a search engines generates a script that is executed when a hyperlink is selected (col. 36-50 and col. 8, lines 1-27) and highlighting the search term (fig. 9 and col. 4, lines 8-18).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley with the teachings of Belfiore, wherein the searching trademark from a trademark database from

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a user at a computer over the Internet in the system provided therein (Coakley's fig. 1), would incorporate the use of searching URL address of Web page, accessing and searching the Web page's content of URL address and providing search results, in the same conventional manner as described by Belfiore (col. 5, lines 10-40 and lines 40-55). The motivation being to provide a search over the Internet for potentially user of trademarks in domain names and other web page content, thereby enforcing the trademark rights within the whole Internet.

Claim 6 is essentially the same as claim 1 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 7 is essentially the same as claim 2 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 8 is essentially the same as claim 3 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 9 is essentially the same as claim 4 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove.

With respect to claim 11, Coakley teaches a remote computer system connected to the computer system via the Internet for accessing the software program (fig. 1).

Claim 12 is essentially the same as claim 1 except that it is directed to a software program for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 13 is essentially the same as claim 2 except that it is directed to a software program for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 14 is essentially the same as claim 3 except that it is directed to a software program for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 15 is essentially the same as claim 4 except that it is directed to a software program for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove.

With respect to claim 17, Coakley teaches a method of searching as discussed in claim 1:

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018). Coakley does not clearly teach wherein the search contents includes at least two of the following portions of the Web page: a domain name, a meta tag, hidden text, visible text, titles and images.

However, Belfiore teaches HTML document or meta tag of HTML and hyperlinks (see fig. 9 and col. 7, lines 6-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley with the teachings of Belfiore, wherein the searching trademark from a trademark database from a user at a computer over the Internet in the system provided therein (Coakley's fig. 1), would incorporate the use of searching URL address of Web page, accessing and searching the Web page's content of URL address and providing search results, in the same conventional manner as described by Belfiore (col. 5, lines 10-40 and lines 40-55). The motivation being to provide a search over the Internet for potentially user of trademarks in domain names and other web page content, thereby enforcing the trademark rights within the whole Internet.

With respect to claim 19, Coakley teaches a method of searching as discussed in claim 6.

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018). Coakley does not clearly teach wherein the search contents includes at least two of the following portions of the Web page: a domain name, a meta tag, hidden text, visible text, titles and images.

However, Belfiore teaches HTML document or meta tag of HTML and hyperlinks (see fig. 9 and col. 7, lines 6-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley with the teachings of Belfiore, wherein the searching trademark from a trademark database from a user at a computer over the Internet in the system provided therein (Coakley's fig. 1), would incorporate the use of searching URL address of Web page, accessing and searching the Web page's content of URL address and providing search results, in the same conventional manner as described by Belfiore (col. 5, lines 10-40 and lines 40-55). The motivation being to provide a search over the Internet for potentially user of trademarks in domain names and other web page content, thereby enforcing the trademark rights within the whole Internet.

With respect to claim 23, Coakley teaches a method of searching as discussed in claim 1.

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018). Coakley does not clearly teach wherein the report displays the at least one character string in a column format for at least one of the meta-tag, the hidden text, the text, the title, the hyperlink, and the image text.

However, Belfiore teaches displaying the search results in the report as a text file, or HTML(col. 5, lines 6-59 and col. 6, lines 8-67; also see abstract see fig. 9 and col. 7, lines 6-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley with the teachings of Belfiore, wherein the searching trademark from a trademark database from a user at a computer over the Internet in the system provided therein (Coakley's fig. 1), would incorporate the use of searching URL address of Web page, accessing and searching the Web page's content of URL address and providing search results, in the same conventional manner as described by Belfiore (col. 5, lines 10-40 and lines 40-55). The motivation being to provide a search over the Internet for potentially user of trademarks in domain names and other web page content, thereby enforcing the trademark rights within the whole Internet.

Claim 26 is essentially the same as claim 23 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 23 hereinabove.

8. Claims 5, 10, 16, 18, 20, 21, 22, 24, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0194116 A1 of Coakley in view of US Patent No. 6,009,459 issued to Belfiore et al. (hereinafter Belfiore) and further in view of US Patent No. 6,422,523 issued to Siegel .

With respect to claim 5, Coakley teaches receiving, from a user, the at least one trademark, tradename, celebrity name, and/or famous name to be searched in the Web page on the Internet (receiving a search request from a user at computer for search trademarks typically based upon a particular goods description or services description or trademark classification; sections 0017; also see section 0015);

automatically creating a search string based on the at least one trademark, tradename, celebrity name, and famous name entered by the user (the search string or search request for a trademark is determined by trademark brokerage engine that checks or determine the search request is available for any trademark within the trademark database: sections 0016 and 0018);

determining an unauthorized use of the at least one trademark, tradename, celebrity name and/or famous name (trademark brokerage engine that checks or determine the search request is available for any trademark within the trademark database: sections 0016 and 0018); and

informing the owner of the unauthorized use (sections 0006 and 0021).

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark

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brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018) and the owners of the trademark (fig. 5). Coakley does not clearly teach receiving a URL address of Web page on the Internet to be searched, accessing and searching contents of the Web page of the URL address received for matches in the contents of the web page corresponding to the search string wherein the searched contents includes elements other than only a domain name, and providing search results of identified matches in the contents of Web page corresponding to the search string, providing search results of identified matches in the contents of the Web page corresponding to the search string, each category including at least one character string corresponding to a number of occurrences of the identified matches within the category, the category selected from the group consisting of a meta-tag, a hidden text, a text, a title, a hyperlink, and an image text, and wherein the report displays the at least one character string.

However, Belfiore teaches after the searching, the search engine locates the URL addresses of web pages on the Internet (col. 5, lines 40-50); the content of web page is located by search engine, and the content of web page is displayed, web page is typically encoded in HTML and most HTML document is identified by a tag or meta tag that gives the elements names and attributes, followed by a content, followed by an end tag. When the search string is found a matched web page is retrieved by a server and or a HTML document is returned, that is, the searched content is including text, URL, HTML (col. 5, lines 40-55), and the search results are displayed as the entered-text is matched based on the search string, that is, entered text or search string

retrieved from a search engine from which search results or given web pages are obtained and displayed to the user (col. 5, lines 10-30).

Therefore, based on Coakley in view of Belfiore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the teachings of Belfiore to the system of Coakley for the user-entered search string including at least one of trademark, tradename, celebrity name or famous name to search in the Web page on the Internet in order to get the search result based on the user-entered search query/string. Coakley and Belfiore do not teach automatically creating homonyms and phonetic for the at least one trademark, tradename, celebrity name or famous name entered by user.

However, Siegel teaches talking database and dictionary database including a plurality of words and distribution of the sounds of them (col. 11, lines 38-67 and col. 12, lines 1-9 and lines 47-50; also see col. 7, lines 58-62).

Therefore, based on Coakley in view of Belfiore and further Siegel, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the teachings of Siegel to the system of Coakley for the constructing homonyms and phonetic of the at least one trademark, tradename, celebrity name or famous name entered by the user. The motivation being to enforce the trademark rights within the whole Internet.

Claim 10 is essentially the same as claim 5 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 5 hereinabove.

Claim 16 is essentially the same as claim 5 except that it is directed to a software program for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 5 hereinabove.

With respect to claim 18, Coakley teaches a method of searching as discussed in claim 5.

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018). Coakley does not clearly teach wherein the search contents includes at least two of the following portions of the Web page: a domain name, a meta tag, hidden text, visible text, titles and images.

However, Belfiore teaches HTML document or meta tag of HTML and hyperlinks (see fig. 9 and col. 7, lines 6-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley with the teachings of Belfiore, wherein the searching trademark from a trademark database from a user at a computer over the Internet in the system provided therein (Coakley's fig. 1), would incorporate the use of searching URL address of Web page, accessing and searching the Web page's content of URL address and providing search results, in the

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same conventional manner as described by Belfiore (col. 5, lines 10-40 and lines 40-55). The motivation being to enforce the trademark rights within the whole Internet.

With respect to claim 20, Coakley teaches a software program on a computer system of searching as discussed in claim 16.

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018). Coakley does not clearly teach wherein the search contents includes at least two of the following portions of the Web page: a domain name, a meta tag, hidden text, visible text, titles and images.

However, Belfiore teaches HTML document or meta tag of HTML and hyperlinks (see fig. 9 and col. 7, lines 6-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley with the teachings of Belfiore, wherein the searching trademark from a trademark database from a user at a computer over the Internet in the system provided therein (Coakley's fig. 1), would incorporate the use of searching URL address of Web page, accessing and searching the Web page's content of URL address and providing search results, in the same conventional manner as described by Belfiore (col. 5, lines 10-40 and lines 40-55). The motivation being to enforce the trademark rights within the whole Internet.

With respect to claim 21, Coakley teaches wherein the at least one character string is a number of the identifying matches within the category (the result of search query: abstract and sections 0017-0018).

Claim 22 is essentially the same as claim 21 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 21 hereinabove.

With respect to claim 24, With respect to claim 20, Coakley teaches a system of searching as discussed in claim 5.

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018). Coakley does not clearly teach wherein the report displays the at least one character string in a column format for at least one of the meta-tag, the hidden text, the text, the title, the hyperlink, and the image text.

However, Belfiore teaches displaying the search results in the report as a text file, or HTML (col. 5, lines 6-59 and col. 6, lines 8-67; also see abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley with the teachings of Belfiore, wherein the searching trademark from a trademark database from a user at a computer over the Internet in the system provided therein (Coakley's fig. 1),

would incorporate the use of searching URL address of Web page, accessing and searching the Web page's content of URL address and providing search results, in the same conventional manner as described by Belfiore (col. 5, lines 10-40 and lines 40-55). The motivation being to enforce the trademark rights within the whole Internet.

Claim 25 is essentially the same as claim 24 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 24 hereinabove.

Claim 27 is essentially the same as claim 24 except that it is directed to a system for searching and reporting an incidence rather than a method, and is rejected for the same reason as applied to the claim 24 hereinabove.

9. Claims 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0194116 A1 of Coakley in view of US Patent No. 6,009,459 issued to Belfiore et al. (hereinafter Belfiore) and further in view of US Patent No. 6,422,523 issued to Siegel and US Patent No. 5,881,131 issued to Farris et al. (hereinafter Farris).

With respect to claims 28-29, Coakley in view of Belfiore and Siegel discloses a system as discussed in claim 5.

Coakley, Belfiore and Siegel disclose substantially the invention as claimed.

Coakley, Belfiore and Siegel do not teach wherein the information relating to the owner of the URL address conducting the unauthorized use includes a name and an

address and wherein informing the owner of the unauthorized use includes delivering a cease and desist letter.

However, Farris teaches URL address and trademark owner's name (col. 30, lines 28-67 and col. 31, lines 1-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley in view of Belfiore and Siegel with the teachings of Farris by incorporating the use of a URL address and name of trademark owner for detecting the web page or web server. The motivation being to enforce the trademark rights within the whole Internet.

With respect to claims 30-31, Coakley in view of Belfiore and Siegel discloses a system as discussed in claim 10.

Coakley, Belfiore and Siegel disclose substantially the invention as claimed.

Coakley, Belfiore and Siegel do not teach wherein the information relating to the owner of the URL address conducting the unauthorized use includes a name and an address and wherein informing the owner of the unauthorized use includes delivering a cease and desist letter.

However, Farris teaches URL address and trademark owner's name (col. 30, lines 28-67 and col. 31, lines 1-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley in view of Belfiore and Siegel with the teachings of Farris by incorporating the use of a URL address and

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name of trademark owner for detecting the web page or web server. The motivation being to enforce the trademark rights within the whole Internet.

With respect to claims 32-33, Coakley in view of Belfiore and Siegel discloses a system as discussed in claim 16.

Coakley, Belfiore and Siegel disclose substantially the invention as claimed.

Coakley, Belfiore and Siegel do not teach wherein the information relating to the owner of the URL address conducting the unauthorized use includes a name and an address and wherein informing the owner of the unauthorized use includes delivering a cease and desist letter.

However, Farris teaches URL address and trademark owner's name (col. 30, lines 28-67 and col. 31, lines 1-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Coakley in view of Belfiore and Siegel with the teachings of Farris by incorporating the use of a URL address and name of trademark owner for detecting the web page or web server. The motivation being to enforce the trademark rights within the whole Internet.

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10. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0194116 A1 of Coakley in view of Pub. No.: US 2004/0019535 A1 of Perkowski and further in view of Pub. No.: US 2002/0147724 A1 of Fries et al. (hereinafter Fries).

With respect to claim 34, Coakley teaches receiving, from a user, the at least one trademark, tradename, celebrity name, and/or famous name to be searched in the Web page on the Internet (receiving a search request from a user at computer for search trademarks typically based upon a particular goods description or services description or trademark classification; sections 0017; also see section 0015);

Forming a search string based on the search term (the search string or search request for a search term, a trademark is determined by trademark brokerage engine that checks or determine the search request is available for any trademark within the trademark database: sections 0016 and 0018);

storing the search string in the first database (the search request is stored in the trademark database (abstract, sections 0016-0017 and 0044).

queuing the search string for a scheduled search (section 0018 and 0031);

identifying an owner of a domain associated with the at least one web page (section 0005);

determining whether the at least one web page constitutes an unauthorized use of the search term (trademark brokerage engine that checks or determine the search request is available for any trademark within the trademark database: sections 0016 and 0018); and

a report engine preparing a report comprising the at least one set of information, wherein the report details in which one or more of a plurality of portions of the at least one web page the search string appears and provides an identification of owner of the domain associated with the at least one web page (abstract, and sections 0043-0044; also see sections 0005 and 0016).

Coakley teaches receiving search request, search string or search query entered from a user at computer to search for trademarks, which are registered marks in trademark database. The search string is determined or created by trademark brokerage engine, which determines whether any trademarks within trademark database satisfying such a search request (sections 0016-0018) and the owners of the trademark (fig. 5). Coakley does not clearly teach at least one search engine to produce a search result comprising at least one URL and storing the at least one URL in a second database and storing the at least one set information in a third database.

However, Perkowski teaches URL databases and web pages including separate databases such first, second and third database for storing information and URL (sections 0023, 0053-0054; also see section 0148-0150).

Therefore, based on Coakley in view of Perkowski, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the teachings of Perkowski to the system of Coakley for performing the search in order to produce a search result including URL, which is stored in the database. Coakley and Perkowski do not teach a crawler application retrieving the at least one URL from the second database, the crawler application retrieving at least one web page associated

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with the at least one URL and parsing the at least one web page to identify at least one set of information associated with the at least one web page and comprising the search string.

However, Fries teaches web browser application using the URL to retrieve the URL's page (sections 0103-104) and parsing the web page (sections 0006, 00012, 0085 and 0095).


Therefore, based on Coakley in view of Perkowski and further Fries, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the teachings of Fries to the system of Coakley for browsing the retrieved web page associated with at least one URL. The motivation being to enforce the trademark rights within the whole Internet.


Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV or fax to **(571) 273-4039**. The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or **Primary Examiner Jean Corrielus (571) 272-4032**.

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JUL. 29th, 2005


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